

REMARKS

Claims 1, 9, 12, 16 through 25, 30, 32, 36, 40, and 42 through 45 are pending in this Application. Claims 10, 11, 13 through 15, 17, 31, 33, 37, and 41 have been cancelled without prejudice or disclaimer, claims 1, 9, 12, 18, 23 through 25, 30, 32, and 36 have been amended, and new claims 42 through 45 have been added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the Abstract, FIG. 2, and ¶¶ [0049] through [0052] of the corresponding US Pub. No. 2002/0187772. Applicants submit that the present Amendment does not generate any new matter issue.

Personal Interview of October 20, 2009.

Applicants express appreciation for the Examiner's courtesy in granting and conducting a personal interview on October 20, 2009. During the interview, no agreement was reached.

Claim 23 was rejected under the first paragraph of 35 U.S.C. § 112 for lack of adequate descriptive support.

In the statement of the rejection, the Examiner asserted that the claim recitations "a processor and a memory storing executable instructions that in response to execution by the processor" are not described in the specification. This rejection is traversed.

Initially, literal support is not required by the statute. *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d at 923; *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566-67 (Fed.Cir.1997). An applicant need not utilize any particular form of disclosure. *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed.Cir.2008) (quoting *In re Alton*, 76

F.3d 1168, 1172 (Fed.Cir.1996)). Further, a patent applicant has the right to narrow an originally disclosed invention. *In re Johnson*, 558 F.2d 1008 (C.C.P.A.)

In applying the above legal tenets to the exigencies of this case, Applicants submit that the imposed rejection is not factually accurate. Applicants respectfully submit that the corresponding US publication fully supports the above claim recitation. Specifically, a processor means 6 and a data storage means 7 of a mobile station 1 are shown in FIG. 1 and discussed in ¶ [0028] of the corresponding US publication. The recitation of “a computer readable storage medium” in claim 23 is fully supported by at least data storage means 7.

In addition, Applicants respectfully submit that one of ordinary skill in the art with the disclosure of the specification would have understood that “executable instructions” and “computer program code” are inherently embodied on a medium, such as the data storage means 7. Certainly, one having ordinary skill in the art would have understood that Applicants had possession of the claimed invention at the time the application was filed. Applicants therefore submit that the imposed rejection of claim 23 under the first paragraph of 35 U.S.C. § 112 for lack of adequate descriptive support is not factually viable and, hence, solicit withdrawal thereof.

Claims 1 and 23 were rejected under 35 U.S.C. §112, second paragraph.

In the statement of the rejection, the Examiner asserted a lack of antecedent basis for “said automatically inserted transaction information” in claims 1 and 23. In response, the antecedent basis issue has been addressed by removing “transaction” in claims 1 and 23, thereby overcoming the stated basis for the rejection. Applicants therefore solicit withdrawal of the rejection of claims 1 and 23 under the second paragraph of 35 U.S.C. §112.

Claims 1, 9 through 25, 30, 33, 36, 37, 40, and 41 were rejected as obvious under 35 U.S.C. §103(a) based on *Breck et al.* (US 2004/0210449, “*Breck*”) in view of *Pennell et al.* (US 2002/0013788, “*Pennell*”) and *Kiessling et al.* (US 6,915,124, “*Kiessling*”).

In stating the rejection, the Examiner concluded that one having ordinary skill in the art would have been led to modify *Breck*'s transaction system by verifying internally user's ID code in view of *Pennell* to improve system security. The Examiner further concluded that that one having ordinary skill in the art would have been led to modify whatever system and method can be said to have been reasonably suggested by the combined disclosures of *Breck* and *Pennell* by including a Subscriber Identity Module (SIM) ID code in view of *Kiessling*, in order to improve executing data authorized by SIM. Applicants respectfully traverse this rejection.

The claimed inventions advantageously enable a user to authorize the insertion of data in the data fields in a form based on an identification code associated with the user equipment (e.g., an SIM series number, etc.). An SIM serial number (SSN) has 19 digits, an IMSI is usually 15 digits long, and an IMEI has a 14 decimal digits plus a check digit. These codes are not only unique, but also long thus providing stronger protection than regular PINs or passwords.

For example, the user equipment verifies internally that the automatic information insertion procedure is allowed. The user equipment may ask for the ID code every time the controller of the wallet function recognizes that a form is to be filled in. As another example, the automatic form filling is in an authorized state if the ID code was verified when the user equipment was switched on (¶¶ [0049] through [0051]).

Specifically, independent claims 1 and 23 recite, *inter alia*: “verifying internally at said user equipment, on the basis of an identification code that associates with the user equipment **and input by a user**, that automatically insertion of information into at least one of said data

fields of said information entity is allowed **by the user**, the identification code being one of a Subscriber Identity Module (SIM) serial number, **or an international mobile station equipment identity (IMEI) code**, or an internal mobile subscriber identity (IMSI) code.”

As admitted by the Examiner (p. 4, second paragraph of the Office Action), *Breck* and *Pennell* do not teach the identification code is a Subscriber Identity Module (SIM). The Examiner then turned to *Kiessling* looking for the missing teaching. However, *Kiessling* fails to cure the above-discussed deficiencies of *Breck* and *Pennell*. This is because *Kiessling* only uses the *secret/private key* in the SIM card (col. 3, lines 36 through 39) to **sign** the data to be sent with the secret/private key for a secured transaction (col. 4, lines 16 through 25). *Kiessling* does not use a SIM serial number, an IMEI code, or an IMSI code as a PIN or a password.

All the three applied references, individually or in combination, fail to disclose or suggest “verifying internally at said user equipment, on the basis of an identification code that associates with the user equipment and input by a user, that automatically insertion of information into at least one of said data fields of said information entity is allowed by the user, the identification code being one of **a Subscriber Identity Module (SIM) serial number, or an international mobile station equipment identity (IMEI) code, or an internal mobile subscriber identity (IMSI) code**”, as recited in the independent claims.

It is therefore apparent that even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite realistic motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir.1988). Applicants, therefore, submit that the imposed rejection of claims 1, 9 through 25, 30, 33, 36, 37, 40, and 41 under 35 U.S.C. § 103 for obviousness based on *Breck* in

view of *Pennell* and *Kiessling* is not factually or legally viable and, hence, solicit withdrawal thereof.

New claims 42 through 45.

New independent claim 45 recites similar features as independent claims 1 and 23 and, hence, are free of the applied prior art for reasons advocated *supra* with respect to independent claims 1 and 23.

New claims 42 through 44 depend from claim 1 and are free of the applied prior art for reasons advocated *supra* with respect to claim 1. Further, Applicants separately argue the patentability of claim 42 through 44 based upon the limitations expressed therein.

In particular, the applied prior art is silent with respect to the limitation in claim 42, i.e., the information automatically inserted is available internally at the user equipment without accessing an external database external to the user equipment. *Breck* requires the involvement of a credit card company (§ [0048]) to facilitate the transaction between a cardholder and a merchant. Therefore, *Breck* needs to retrieve information of the cardholder's account from a secondary transaction number (STN) database 6 (§ [0066]), and then automatically inserts information into data fields of a form based on the retrieved information from the STN database 6. *Breck* does not insert in the form based on information internally at the user equipment without accessing an external database.

Pennell determines whether a form format is scripted or not (i.e., whether the user filled out the same form before with personal data) (§ [0023], [0027]), and then asks **the user to select** one set of the user's login names and passwords to a specific website (§ [0033]), rather than **automatically verifying internally** at said user equipment, on the basis of an identification

code that associates with the user computer 301. In particular, the user's login names and passwords are associated with the user and websites, rather than with the user computer 301. *Kiessling* does not insert the information automatically in a form, but only uses the secret/private key in the SIM card to sign the data for a secured transaction. Accordingly, claims 42 through 44 are free of the applied prior art.

Based upon the foregoing, it is apparent that the imposed rejections have been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-519-9954 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

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Date

/Arthur J. Steiner/

Arthur J. Steiner

Attorney for Applicant(s)

Reg. No. 26106

Chih-Hsin Teng

Attorney for Applicant(s)

Reg. No. 63168

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9951
Fax (703) 519-9958